UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/063,124	03/22/2002	Chris Sandoval	FMC 1371 PUSP / 201-0013	5947

28395 7590 09/25/2009

BROOKS KUSHMAN P.C./FGTL
1000 TOWN CENTER
22ND FLOOR
SOUTHFIELD, MI 48075-1238

EXAMINER	
BOSWELL, BETH V	

ART UNIT	PAPER NUMBER
3623	

MAIL DATE	DELIVERY MODE
09/25/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRIS SANDOVAL, CHARLES A. SELKE, CHARLES H. WATSON, FREDERICK P. ELLERT, JEFFRY GRUPP, KALYAN DUTTA, KATHRYN HOWE-VANDELINDER, SAUNDRA ELNORA LAMB, TERRENCE BERNDT and VISH DAITA

Appeal 2009-000175
Application 10/063,124
Technology Center 3600

Decided: September 25, 2009

Before, MURRIEL E. CRAWFORD, ANTON W. FETTING, and JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b). (2002).

SUMMARY OF DECISION

We REVERSE and ENTER A NEW GROUND pursuant to 37 C.F.R. § 41.50(b).

THE INVENTION

Appellants claim a method for the implementing best practice processes within one or more functional units across an organization. (Spec. 1: ¶[0002]).

Independent claims 1 and 18, reproduced below, are representative of the subject matter on appeal.

1. A method for implementing a best practice idea within an organization comprising:

receiving at least one best practice idea from one or more best practice requesters;

assigning the best practice idea to a best practice process ownership team and

at least one functional champion within the organization wherein the process ownership team and the at least one functional champion analyze the best practice idea to confirm that the best practice idea is a best practice, assess the feasibility of the best practice, and are responsible for the development and implementation of the best practice idea;

presenting the best practice idea to at least one executive sponsor for approval and commitment wherein the at least one executive sponsor possesses the executive authority to exercise organizational resources necessary to develop and implement the best practice idea;

defining a project plan for the best practice idea wherein the project plan tracks any necessary steps for developing and implementing the best practice idea;

developing the best practice idea according to the project plan; and

deploying the best practice idea within at least one organizational function.

18. A method for implementing best practice processes within an organization comprising:

a step for initiating at least one best practice idea;

a step for analyzing the at least one best practice idea and selecting one or more of the at least one best practice idea to implement;

a step for developing the selected best practice idea(s);

a step for approving the selected best practice idea(s); and a step for deploying the selected best practice idea(s).

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Baker, Sunny, The Complete Idiot's Guide to Project Management; Alpha Books, (2000)

The following rejection is before us for review.

The Examiner rejected claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over Baker.

ISSUE

Have Appellants shown that the Examiner erred in rejecting claims 1-20 on appeal as being unpatentable under 35 U.S.C. § 103(a) over Baker on the grounds that a person with ordinary skill in the art would understand that a guide to project management is a best practice?

PRINCIPLES OF LAW

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR*

Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

The test to determine whether a claimed process recites patentable subject matter under § 101 is whether: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. *In re Bilski*, 545 F.3d 943, 961-62 (Fed. Cir. 2008) (en banc).

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. Appellants define 'best practice' in their published Specification US 2003/0004766 A1, ¶[0025] as "the most effective way to execute a specific business process, task or objective."

2. Appellants' Specification further describes 'best practice' as "… the result of adapting efficient tools and methods to the environment, culture and needs of an organization. Traditional best practice processes involve surveys and benchmarking to identify best practice processes among all existing processes or potential alternatives." (Spec. 1:¶[0004]).

3. Baker discloses

> [p]roject prioritization and selection is the first of many decisions in the initiation phase. In this chapter, you will learn how to prioritize the projects in your area of responsibility into those that need to be done now, those that should be started later, and those that simply should be scratched off the list and forgotten. (Baker, p. 56).

4. Baker discloses on pages 57-58 steps 2-7 all of which are directed to analyzing plural projects and eliminating those which are inappropriate or unfeasible and prioritizing the rest.

ANALYSIS

We reverse the rejection of claims 1-20 and enter a new grounds of rejection under 35 U.S.C. § 101 as to claims 1-13, 18-20.

Appellants define "best practice" as "the most effective way to execute a specific business process, task or objective." (FF 1). The Examiner however maintains that "[a]lthough a 'best practice' is different from a project, best practices can be applied to the business processes of project management and a project can include implementing a best practice." (Ans. 10).

We cannot agree with the Examiner because Baker discloses a project management guide which is in of and itself a separate process from a best practice process. Even if we assume that Baker is a best practice for project management, Baker discloses a project management process for selecting projects, which selected projects then cannot then themselves also be called best practices. More specifically, the Examiner found that the project "Open Cucamongo sale office" is

implementing and executing a specific business objective in accordance with Appellants' definition of a business practice. (Ans. 10). But, the process which is described associated with "Open Cucamongo sale office" on pages 57-58 of Baker, is disclosed as part of steps 2-7, all of which are directed to "analyzing plural projects and eliminating those which are inappropriate or unfeasible and prioritizing the rest." (FF 3, 4). If the general process of eliminating projects is itself the best practice as the Examiner initially suggests, then the projects on which decisions are made cannot also be a best practice too. There needs to be an additional teaching for using the singular project management process of Baker in a best practice application which we do not find in the rejection. This is a core factual finding in a determination of patentability, and the Board, for such issues, cannot simply reach conclusions based on its own understanding or experience. Rather, the Examiner must point to some concrete evidence in the record in support of these findings. *In re Zurko*, 258 F.3d 1379, 1385 (Fed. Cir. 2001). Accordingly, we cannot sustain the rejection of independent claims 1 and 18 which require this distinction.

Since claims 2-17, 19-20 depend from claims 1 and 18, and since we cannot sustain the rejection of claims 1 and 18, the rejection of the dependent claims likewise cannot be sustained.

35 U.S.C. § 101 Rejection

Claims 1-13, 18-20 fail to recite patent-eligible subject matter under § 101 because these claims fail to be (1) tied to a particular machine or apparatus, or (2) transform a particular article into a different state or thing. *In re Bilski*, 545 F.3d

943, 961-62 (Fed. Cir. 2008) (en banc).

We therefore, pursuant to our authority under 37 C.F.R. § 41.50(b), enter a new ground of rejection for claims 1-13, 18-20 for the reasons set forth above.

CONCLUSIONS OF LAW

We conclude the Appellants have shown that the Examiner erred in rejecting claims 1-20.

We enter a new ground of rejection of claims 1-13, 18-20 under 35 U.S.C. § 35 U.S.C. § 101.

DECISION

The decision of the Examiner to reject claims 1-20 is reversed.

This decision also contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." This Decision contains a new rejection within the meaning of 37 C.F.R. § 41.50(b) (2007).

37 C.F.R. § 41.50(b) also provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new rejection:

> (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .
>
> (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the Appellants elect to prosecute further before the examiner pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REVERSED ; 37 C.F.R. § 41.50(b).

JRG

BROOKS KUSHMAN P.C./FGTL
1000 TOWN CENTER
22ND FLOOR
SOUTHFIELD, MI 48075-1238